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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,667	11/12/2003	Robert E. Dickerson	84506JLT	8042

7590 09/27/2004
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EXAMINER

SCHILLING, RICHARD L

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 09/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/706,667	Applicant(s) DICKERSON ET AL.	
	Examiner Richard L. Schilling	Art Unit 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11-12-03</u> . | 6) <input type="checkbox"/> Other: ____. |

1. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent.

In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of copending application Serial No. 10/712,389; claims 1-17 of copending Application Serial No. 10/706,340; claims 1-19 of copending Application Serial No. 10/706,574 and claims 1-20 of copending Application Serial No. 10/706,529. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application and the copending applications are essentially the same except for the speed ranges of the systems which ranges substantially overlap. The copending applications set forth oxidized gelatin binders for the silver

halide grains in their specification and dependent claims.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

2. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-15, 17, 19 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Dickerson et al. '586 and Maskasky. Dickerson et al. '586 (see particularly column 5, lines 45-57; column 4, lines 32-67; column 9, lines 18-47; column 10, lines 60-67; column 11, lines 30-60; column 12, lines 17-30; the Example) discloses radiographic silver halide film with two tabular silver halide grain emulsions coated on each side of the support with the inner silver halide emulsions containing crossover control agents. The tabular silver halide grains have aspect ratios of at least 15 and

include those with diameters greater than 3 microns. Silver halide grains with over 90% bromide are used. The binders for the silver halide emulsions in Dickerson et al. '586 include oxidized gelatin binders. Maskasky (see particularly column 2, lines 1-25; column 3, lines 19-27; column 9, lines 7-52) discloses making tabular silver halide grains as used in Dickerson et al. wherein oxidized gelatin is used containing at least .25% of oxidized gelatin for reduced rod population and thinner and/or larger diameter tabular grains. Since Maskasky discloses advantages of using oxidized gelatin for tabular silver halide grains as set forth in Dickerson et al. including tabular silver halide grains used in radiographic films, it would be obvious to one skilled in the art to use the disclosed oxidized gelatin binders as the called for binders in Dickerson et al. with at least .25% oxidized gelatin as set forth in Maskasky. Since Dickerson et al. use silver halide emulsions within the scope of the tabular silver halide grains of the instant claims, the silver halide speeds of Dickerson et al. would inherently be the same as the instant claims. Alternatively, it would at least be obvious to one skilled in the art to use high speed silver halide emulsions in Dickerson et al. particularly since Dickerson et al. discloses adding dopants to increase speed.

3. The prior art submitted by applicants has been

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considered. Dickerson et al. '554 is cited of interest in the art as disclosing radiographic films comprising two tabular silver halide emulsions on each side of a support.

4. Any inquiry concerning this communication should be directed to Mr. Schilling at telephone number (571) 272-1335.

RLSchilling:cdc

September 22, 2004

RICHARD L. SCHILLING
PRIMARY EXAMINER
GROUP #100 1752

